REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on June 16, 2004. Claims 9-11 are pending and stand rejected in this Application. Claim 9 is amended and Claim 12 is cancelled without prejudice or disclaimer by the present Amendment.

Claims 9-12 were rejected under 35 U.S.C. §102(e) as being anticipated by Woo (U.S. Patent No. 6,217,432, hereinafter "Woo"). Applicants respectfully submit that Claim 9 is not anticipated by Woo because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited reference. In an anticipation rejection, MPEP § 2131 requires that the identical invention must be shown in as complete detail as is contained in the claim.

According to a feature of the invention as set forth in Claim 9, a method of producing a processing tool with abrasive grains for grinding the surface of a silicon work-piece, is recited comprising, among other features, mixing a binder and silica grains to form a mixture, the binder being made of a material that generates no endothermic reaction during the process carried out on the silicon work-piece by the processing tool.

As disclosed in the Specification, the silica used in the processing tool generates a mechano-chemical reaction with respect with silicon, but will not form a residual contamination resulting from the mechano-chemical reaction between the silica and silicon.[1] However, in order to assure that the mechano-chemical reaction occurs, it is necessary that the processing ambient temperature be sufficiently high. If the binder is made of a material with a low melting point, an endothermic reaction will take place when the binder melts due to the heat generated during the grinding process, causing the process temperature to decrease, thereby making it virtually impossible to generate the necessary mechano-chemical reaction at the decreased processing ambient temperature.[2] Claim 9 has been amended to more clearly recite such an advantageous process.

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[1] See, for example, Specification, page 11, line 21 – page 13, line 1.

The outstanding Office Action asserts that Woo teaches a method of producing a processing tool which generates no endothermic reaction. Applicants respectfully disagree. In the section of Woo cited in the outstanding Office Action, a list of thermoplastic binders is provided.[3] Applicants respectfully submit that the listed thermoplastic binders will melt during the grinding process, thereby generating the unwanted endothermic reactions.

Applicants respectfully submit that Claim 9 is not anticipated by Woo. This cited prior art reference does not disclose a binder made of a material that generates no endothermic reaction during the process carried out on the silicon work-piece by the processing tool. In addition, Claims 10 and 11 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1, which should be allowed. Therefore, Applicants respectfully request that the anticipation of Claims 9-11 under 35 U.S.C. §102(e) be withdrawn.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 9-11 is earnestly solicited.

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[2] See, for example, Specification, page 13, line 15 – page 14, line 2.

[3] "Examples of suitable thermoplastic polymers include polyamides, polyethylene, polypropylene, polyesters, polyurethanes, polyetherimide, polysulfone, polystyrene, acrylonitrile-butadiene-styrene block copolymers, styrene-butadiene-styrene block copolymers, styrene-isoprene-styrene block copolymers, acetal polymers, polyvinyl chloride and combinations thereof." Woo, col. 8, lines 57-64.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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